

REMARKS

Reconsideration of this application in view of the above amendments and the following remarks is respectfully requested.

STATUS OF CLAIMS AND SUPPORT FOR AMENDMENTS

Upon entry of this amendment, claims 1-24 will be pending in this application.

Support for the amendment to claims 1, 9, and 17 can be found in the specification at paragraph [0053].

Applicants note with appreciation the indication that claims 6 and 14 are allowable over the art of record. For the rejections given below, Applicants submit that all of the claims are allowable.

INDEFINITENESS REJECTION

In paragraphs 1-3 of the Office action dated November 14, 2008, the Office has rejected claims 1-8 under 35 U.S.C. § 112, second paragraph, as indefinite.

Applicants respectfully traverse this rejection for the reasons given below.

The Office states:

With respect to claim[s] 1-8, these [claims] are 'device [claims]', but there are no hardware structural [components] found. A position information recognizing part, an attribute recognizing part, a file producing part, and a sequence setting part in [the claims read] as software modules which are processes.

Office action dated November 14, 2008 at page 3.

This is not a rationale sufficient to support a rejection for indefiniteness under 35 U.S.C. § 112, second paragraph. Applicants do not admit that the Office's interpretation of the position information recognizing part, the attribute recognizing part, the file producing part, and/or the sequence setting part as "software modules" is correct. However, even assuming, arguendo, that this interpretation is correct, the

Office does not explain how its interpretation renders claims 1-8 indefinite. The Office provides no explanation of any ambiguity in the claims, or any explanation as to why one skilled in the art would not be able to determine whether or not an image processing device falls within the scope of claims 1-8. Applicants submit that a skilled worker in this art would readily be able to determine whether a particular image processing device has the recited parts, and therefore whether it falls within the scope of Applicants' claims. This is all that is required for Applicants' claims to satisfy the requirements of 35 U.S.C. § 112, second paragraph. See *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). Accordingly, Applicants respectfully submit that this rejection should be withdrawn.

REJECTION UNDER 35 U.S.C. § 101

At pages 3-4 of the Office action dated November 14, 2008, the Examiner has rejected claims 9-16 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicants respectfully traverse this rejection based on the remarks below.

The Office action states:

While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled "Clarification of 'Processes' under 35 U.S.C. 101" - publicly available at USPTO.GOV, "memorandum to examining corp"). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. In order for a process to be "tied" to another statutory category, the structure of another statutory category should be positively recited in an step or steps significant to the basic inventive concept, and NOT just in association with statements of intended use or purpose, insignificant pre or post solution activity, or implicitly.

Office action dated November 14, 2008 at pages 3-4 (emphasis added).

First, the May 15, 2008 memorandum referenced by the Office does not appear to be readily available at the U.S. PTO website; providing the memorandum to Applicants might have been a better procedure than reliance on internal PTO memoranda, which may or may not be available to the public.

Second, an even better approach would have been for the Office to follow *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008), which sets forth the "machine or transformation" test for patent-eligible subject matter. If a process is tied to a particular machine or apparatus, then it is patent-eligible subject matter. If a process transforms a particular article to a different state or thing, then it is patentable subject matter. This is true irrespective of whether the Office chooses to characterize the "process limitations" as "statements of intended use or purpose, insignificant pre or post solution activity, or implicit features of the claim."

In the present application, the rejected claims state in their preamble that they are directed to an image processing device. It is difficult to imagine a situation in which any "process limitations" are more closely tied to a particular device than that presented by Applicants' claims. Moreover, even assuming that the Office is correct that the body of the claims contains process limitations because certain features arguably read on "software modules," the result of the operation of these modules is a device in a different state. Accordingly, the claims satisfy the "transformation" test of *Bilski* as well.

For at least the reasons given above, Applicants respectfully submit that the claims are directed to patent-eligible subject matter under 35 U.S.C. § 101, and that this rejection should be withdrawn.

OBVIOUSNESS REJECTIONS

A. Claims 1, 8, 9, 16, 17, and 24 over Tanaka in view of Hoffman et al.

At pages 4-6 of the Office action dated November 14, 2008, the Examiner has rejected claims 1, 8, 9, 16, 17, and 24 under 35 U.S.C. § 103(a) as obvious over U.S. Patent Publication No. 2002/0003897 (Tanaka) in view of U.S. Patent Publication No. 2004/0169664 (Hoffman et al.). Applicant respectfully traverses this rejection for the reasons given below and in the response filed on July 21, 2008 which is incorporated herein by reference.

In the response filed on July 21, 2008, Applicants provided detailed reasons why this rejection was erroneous and should be withdrawn. In the Office action dated November 14, 2008, the Office has failed to address those reasons, except to state:

With respect to [claims] 1, 9, and 17, terms "filled closed area" and "unfilled closed area" are not well known [terms]. Any closed areas that have different color can be read as "filled closed [area]" and "unfilled closed area". Applicant states that paragraph [0007] of the present published application described "filled closed area" and "unfilled closed area" but they are not defined in the claim.

Office action dated November 14, 2008 at page 2. While this statement is not a sufficient reason for the Office to fail to address Applicants' previous arguments, Applicants respectfully submit that claims 1, 9 and 17 do recite the distinction between filled and unfilled closed areas. Accordingly, Applicants respectfully submit that claims 1, 8, 9, 16, 17, and 24 are not obvious over Tanaka in view of Hoffman et al. for the reasons given in the response filed July 21, 2008. Applicants respectfully request that the Office completely and fully address these reasons, in accordance with the requirements of MPEP § 706.07.

B. Claims 2, 10, and 18

At pages 6-7 of the Office action dated November 14, 2008, the Examiner has rejected claims 2, 10, and 18 under 35 U.S.C. § 103(a) as obvious over Tanaka in view of Hoffman et al., as applied to claim 1 and further in view of U.S. Patent Publication No. 2005/0116963 (Bourdev et al.). Applicants respectfully traverse this rejection for the reasons given below and in the response filed on July 21, 2008 which is incorporated herein by reference.

Again, the Office has not addressed the errors in this rejection pointed out in the response filed on July 21, 2008. Applicants submit that claims 2, 10, and 18 are not obvious over Tanaka in view of Hoffman et al. and Bourdev et al. for the reasons given in the response filed July 21, 2008, and respectfully request that the Office completely and fully address these reasons, in accordance with the requirements of MPEP § 706.07.

C. Claims 3, 11, and 19

At page 7 of the Office action dated November 14, 2008, the Examiner has rejected claims 3, 11, and 19 under 35 U.S.C. § 103(a) as obvious over Tanaka, in view of Hoffman et al., and in further view of Bourdev et al., as applied to claim 2 above and further in view of U.S. Patent No. 6,330,363 (Accad). Applicants respectfully traverse this rejection for the reasons given below.

Again, the Office has not addressed the errors in this rejection pointed out in the response filed on July 21, 2008. Applicants submit that claims 3, 11, and 19 are not obvious over Tanaka in view of Hoffman et al. Bourdev et al., and Accad for the reasons given in the response filed July 21, 2008, and respectfully request that the

Office completely and fully address these reasons, in accordance with the requirements of MPEP § 706.07.

D. Claims 4, 12, and 20

At pages 8-9 of the Office action dated November 14, 2008, the Examiner has rejected claims 4, 12, and 20 under 35 U.S.C. § 103(a) as obvious over Tanaka in view of Hoffman et al., and as applied to claim 1 above and further in view of U.S. Patent No. 7,054,029 (Ohta et al.). Applicants respectfully traverse this rejection for the reasons given below.

Again, the Office has not addressed the errors in this rejection pointed out in the response filed on July 21, 2008. Applicants submit that claims 4, 12, and 20 are not obvious over Tanaka in view of Hoffman et al. and Ohta et al. for the reasons given in the response filed July 21, 2008, and respectfully request that the Office completely and fully address these reasons, in accordance with the requirements of MPEP § 706.07.

E. Claims 5, 13, and 21

At pages 9-10 of the Office action dated November 14, 2008, the Examiner has rejected claims 5, 13, and 21 under 35 U.S.C. § 103(a) as obvious over Tanaka in view of Hoffman et al., and as applied to claim 4 above further in view of Ohta et al.. Applicants respectfully traverse this rejection for the reasons given below.

Again, the Office has not addressed the errors in this rejection pointed out in the response filed on July 21, 2008. Applicants submit that claims 5, 13, and 21 are not obvious over Tanaka in view of Hoffman et al. and Ohta et al. for the reasons given in the response filed July 21, 2008, and respectfully request that the Office

completely and fully address these reasons, in accordance with the requirements of MPEP § 706.07.

F. Claims 7, 15, and 23

At page 10 of the Office action dated April 23, 2008, the Examiner has rejected claims 7, 15, and 23 under 35 U.S.C. § 103(a) as obvious over Tanaka in view of Hoffman et al., and further in view of Ohta et al.. Applicants respectfully traverse this rejection for the reasons given below.

Again, the Office has not addressed the errors in this rejection pointed out in the response filed on July 21, 2008. Applicants submit that claims 7, 15, and 23 are not obvious over Tanaka in view of Hoffman et al. and Ohta et al. for the reasons given in the response filed July 21, 2008, and respectfully request that the Office completely and fully address these reasons, in accordance with the requirements of MPEP § 706.07.

CONCLUSION

Applicants submit that this application is in condition for immediate allowance, and an early notification to that effect is respectfully requested. If the Examiner has any questions about this application, or believes that any issues remain to be resolved, the Examiner is respectfully requested to contact the undersigned to arrange for a personal or telephonic interview to resolve these issues prior to the issuance of another Office action.

Respectfully submitted,

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